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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/343,728	06/30/1999	TOSHIHISA SAWADA	P18153	8274

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EXAMINER

SAFAIPOUR, HOUSHANG

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 03/25/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/343,728	SAWADA, TOSHIHISA	
	Examiner	Art Unit	
	Houshang Safaipoor	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 June 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3, 6 & 7</u> | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 8 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The statements underlined in claims 8 and 9 below are vague and indefinite.

Claim 8: A server apparatus registers image files from an image transmitting apparatus described in claim 1 and selects a requested image file when an image receiving apparatus where an image is sent accesses thereto, and transfers the selected Image file thereto.

Claim 9: the apparatus according to claim 8, wherein when said image receiving apparatus where an image is sent accesses to thereto, a menu screen is first transmitted to said image receiving apparatus.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 5-15, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Bobo (U.S. Patent No. 5,675,507).

Regarding claim 1, Bobo discloses an image transmitting apparatus comprising:

filing means for filing image data by unit of page (col. 11, lines 11-14);

registering means for registering a filed image file to a server apparatus (col. 11,

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lines 32-55): and

informing means for transmitting an e-mail including a server address of said server apparatus to a recipient to which said image data should be transmitted (col. 8, lines 22-30).

Regarding claim 2, Bobo discloses the apparatus according to claim 1, wherein said registering means generates image data to be transmitted in a plurality of data formats having a standard data format and a non- standard data format, and registers image data to said server apparatus (col. 19, lines 63-67 and col. 20, lines 1-5).

Regarding claim 5, Bobo the apparatus according to claim 1, wherein a menu screen in which a file name of the image file to be registered to said server apparatus is registered is generated in a form of a structured document, and said generated menu screen is registered to said server apparatus (col. 8, lines 8-30) and (col. 9, lines 30-46).

Regarding claim 6, Bobo discloses the apparatus according to claim 1, wherein when the image files for all pages are prepared, said registering means registers said image files to said server apparatus at one time (col. 10, lines 2-15).

Regarding claim 7, Bobo discloses the apparatus according to claim 1, wherein said registering means sequentially registers said image files every time when the Image file for one page is generated (col. 11, lines 11-55).

Regarding claim 8 (as best understood by the examiner), Bobo discloses a server apparatus registers image files from an image transmitting apparatus described in claim 1 selects a requested image file and transfers the selected Image file (col. 7, lines 38-67).

Regarding claim 9 (as best understood by the examiner), Bobo discloses the apparatus according to claim 8, wherein a menu screen is first transmitted to said image receiving

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apparatus (col. 8, lines 8-30) and (col. 9, lines 30-46).

Regarding claim 10, Bobo discloses an image receiving apparatus comprising:

address extracting means for extracting a server address by use of an e-mail received from an image transmitting apparatus; and image obtaining means for obtaining an image file by unit of page by accessing to a server apparatus using said extracted server address (columns 7-9).

Regarding claim 11, Bobo discloses the apparatus according to claim 10, wherein when image files are registered to the server apparatus in a plurality of data formats, said image obtaining means selects an image file of a data format suitable for an own processing capability and obtains the selected image file (columns 7-9).

Regarding claim 12, Bobo discloses the apparatus according to claim 10, wherein when said image obtaining means first accesses to the server apparatus, said image obtaining means reads a menu screen and displays said menu screen, and receives an selection f or an image file on said menu image, and obtains the selected image file from the server apparatus (col. 8, lines 8-30) and (col. 9, lines 30-46).

Regarding claim 13, Bobo discloses the apparatus according to claim 10, wherein when said image obtaining means fetches page numbers for all pages from the server apparatus and writes the page numbers to a print Instruction buffer, and fetches the image files having page numbers written to the print instruction buffer one page by one, and when a printing for one page is ended, said image obtaining means fetches a next page again (col. 8, lines 53-67 and col. 9, lines 1-30).

Regarding claim 14, Bobo discloses the apparatus according to claim 10, wherein when said image obtaining means writes a page number instructed to be selected to a print instruction

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buffer, and fetches image files written to the print Instruction buffer one page by one, and when a printing for one page is ended, said image obtaining means fetches a next page again (col. 9 and col. 10, lines 1-15).

Regarding claim 15, Bobo discloses the apparatus according to claim 10, further comprising a remote controller with a display separated from the main body of said apparatus, wherein Image data included in the image file received by the main body of said apparatus is transferred to said remote controller with a display so as to be displayed thereon (col. 8, lines 64-67).

Regarding claim 17, Bobo discloses an image transmitting method comprising the steps of:
filing image data by unit of page (col. 11, lines 11-14);
generating a menu screen in which a file name of image data is registered in a form of a structured document (col. 8, lines 8-30);
registering said filed image data and said menu screen to a server apparatus (col. 8, lines 8-30); and
transmitting an e-mail including a server address of said server apparatus to a recipient to which said image data should be transmitted (col. 8, lines 22-30).

Regarding claim 18, Bobo discloses an image receiving method comprising the steps of:
receiving an e-mail including a server address to which image data to itself is registered;
extracting the server address from the received e-mail; accessing to a server apparatus using the extracted server address so as to obtain a menu screen; and obtaining Image data by unit of page using said menu screen (columns 7, 8 and 9).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3, is rejected under 35 U.S.C. 103(a) as being unpatentable over Bobo, II (U.S. Patent No. 5,675,507) and in view of Kumar et al. (U.S. Patent No. 6,240,445).

Regarding claim 3, Bobo does not explicitly disclose the apparatus according to claim 1, further comprising:

storing means storing a table in which a recipient's e-mail address, serving as a recipient, and a server address, serving as a registration destination for an image file, are made to correspond to each other; and server selecting means for selecting the server apparatus corresponding to said e-mail address when the recipient e-mail address is input using said table. Kumar et al. discloses a system capable of performing these functions (col. 7, lines 6-67 and col. 8, lines 1-39). Therefore, it would have been obvious to a person of an ordinary skill in the art at the time the invention was made to combine Kumar's system with that of Bobo's, because this addition would enhance the design and adds convenience for the users.

Claim 4, is rejected under 35 U.S.C. 103(a) as being unpatentable over Bobo, II

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(U.S. Patent No. 5,675,507) and in view of Kumar et al. (U.S. Patent No. 6,240,445) and further in view of Naylor et al. (U.S. Patent Application Publication No. 2002/0062363).

Regarding claim 4, neither Bobo nor Kumar disclose the apparatus according to claim 3, wherein a single button dialing key number allocated to the e-mail address is registered to correspond to the e-mail address and said server selecting means selects a corresponding server apparatus when the single button dialing key number is input. Naylor et al. discloses a system capable of performing such functions (page 1, paragraph [0002]. Therefore, it would have been obvious to a person of an ordinary skill in the art at the time the invention was made to combine Naylor's design with that of Bobo and Kumar's, because this addition would enhance the design and adds convenience for the users.

Claim 16, is rejected under 35 U.S.C. 103(a) as being unpatentable over Bobo, II (U.S. Patent No. 5,675,507) and in view of Tanaka, Miyoshi (JP 4 06141122A).


Regarding claim 16, Bobo does not disclose the apparatus according to claim 10, further comprising a remote controller with a display separated from the main body of said apparatus, wherein said remote controller with a display instructs the main body of said apparatus to write a page number to a print instruction buffer. Tanaka, Miyoshi discloses such system as stated in the abstract. Therefore, it would have been obvious to a person of an ordinary skill in the art at the time the invention was made to combine Tanaka, Miyoshi's design with that of Bobo because this addition would enhance the design and adds convenience for the users.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Houshang Safaipoor whose telephone number is (703)306-4037. The examiner can normally be reached on Mon.-Thurs. from 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L Coles, Sr. can be reached on (703)305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9314 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)306-0377.


Houshang Safaipoor
Patent Examiner
Art Unit 2622
March 16, 2003


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